

REMARKS

Claims 1-27 are pending in the application. Claim 13 is objected to under 35 U.S.C. §112 and claims 1-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art, as described in the written description of the specification.

The Examiner has also deemed the executed Declaration and Power of Attorney for Patent Application ("Declaration") defective because, according to the Examiner, it does not *correctly* identify the specification to which the Declaration is directed. This assertion is apparently based on two numbers being transposed in the application number supplied in the Declaration (10/074,950 instead of 10/047,950), which was filed after the filing date of the application. Notwithstanding two numbers being transposed the Declaration otherwise correctly identifies the application to which the Declaration is directed by a) title, b) attorney docket numbers and c) filing date, all of which are identically contained in the Filing Receipt and Updated Filing Receipt.

37 C.F.R. §1.63(b)(1) requires that an oath or declaration "Identify the application to which it is directed;" MPEP §602.02 delineates that it is *preferable* that the application be identified in the oath or declaration by application number and filing date but these are not required.

MPEP §602.VI. allows for specific combinations of information to be supplied in an oath or declaration filed after the filing date of the application to identify a specification. Compliance with any one of the listed items will be accepted as complying with the identification requirement of 37 C.F.R. §1.63. The listed items include, among others, a) application number, b) serial number and filing date, c) attorney docket number which was on the specification as filed and d) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number or serial number and filing date.

In this respect, the Declaration filed by applicant on June 7, 2002 supplied an erroneous application number that had two numbers transposed in the serial

number portion of the application number (10/074,950 instead of 10/047,950). This Declaration also included a correct filing date (01/15/2002) and an attorney docket number (9D-ED-19976/064853-040), the first portion of which was on the specification as filed in the upper left hand corner (9D-ED-19976). Additionally, this Declaration supplied a title of the invention (Method and Apparatus for Managing the Delivery and Return of Goods), which was on the specification as filed and the Declaration when filed was accompanied by a cover letter accurately identifying the application for which it was intended by either the application number, or serial number and filing date. The Declaration when filed was accompanied by a Transmittal Form, a copy of which is attached hereto, that identifies the application for which the Declaration was intended by a) a correct application number (10/047,950), a correct filing date (01/15/2002) as well as the attorney docket number (9D-ED-19976/064853-040). Moreover, applicant included a copy of the Notice to File Missing Parts, a copy of which is attached hereto, with the Declaration and Transmittal Form. The Notice contains identical information with respect to the application number, filing date and attorney docket number as found in the Declaration and Transmittal Form with the only exception being the two transposed numbers noted above.

To further corroborate that the Declaration clearly identifies the specification to which it is directed, applicant points out that an unsigned declaration was filed with the application on January 15, 2002 that included the names of the inventors and the title of the invention, which was on the specification as filed. This information would be in compliance with the identification requirements of 37 C.F.R. §(b)(1) had the declaration been executed on filing. The later filed and executed Declaration contains the same inventors and title, attorney docket number, application number and filing date. This Declaration's only flaw was the transposition of two numbers in the application number, which would be clearly evident to someone reviewing the file history associated with this application.

In view of the above intrinsic evidence, applicant respectfully submits that a conspicuous typographical error in the originally filed Declaration (10/074,950

instead of 10/047,950) does not alone constitute a substantive defect in that Declaration. Applicant believes that notwithstanding this one typographical error, the intrinsic evidence discussed above overwhelmingly demonstrates that the Declaration unambiguously identifies the application and specification to which it is directed. Thus, applicant respectfully requests that the Examiner withdraw his requirement for a new oath or declaration.

Applicant has amended claim 13 so that it depends from claim 12, and this should remove the basis for the objection regarding claim 13.

Applicant traverses the rejection of claims 1-27 under 35 U.S.C. §103(a).

For the following reasons, applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as detailed in MPEP §§2142 and 2143.

The Examiner rejects claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over the "admitted prior art, as described in the written description of the specification." without specifically identifying any portion of the specification that allegedly constitutes prior art (Office Action, page 3). With respect to this contention, applicant has not labeled, identified or otherwise designated any of the description of the subject matter in the application as "prior art". (see; MPEP §§ 2129 I. and II.). Applicant is unable to determine with specificity what the Examiner asserts is "prior art" in the Background of the Invention section, or elsewhere, in support of his rejection. Applicant requests that whatever the Examiner believes to be prior art be specifically identified so applicant may formulate a response.

The Examiner then goes on to suggest that *applicant* has described the present invention as being "merely a method of using conventional, well known computer equipment in order to implement and effect an automated method for accomplishing the same well known results as had heretofore been accomplished via manual means" (*emphasis added*; Office Action, page 3). A cursory reference is made to the Background of the Invention as presumably providing examples of the "same well known results as had heretofore been accomplished via manual means" without specifically identifying any.

Applicant points out that the Background of the Invention describes information setting the real-life problems encountered by the assignee of the present invention while purveying goods in the market place and the thought processes undertaken by the inventors for recognizing and solving those problems. Applicant submits that subject matter described in the Background of the Invention, or elsewhere in the application, should not be construed as "prior art" absent an express admission, labeling or other designation by applicant, which is clearly not the case. Thus, the Examiner may not use a cursory reference to the Background of the Invention as constituting the necessary prior art upon which the obviousness rejection of claims 1-27 under 35 U.S.C. §103(a) is based without specifically identifying the prior art and why it is prior art.

With respect to the Detailed Description of the Invention, the Examiner rejects claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over the "... admitted prior art, as described in the written description of the specification." without specifically identifying any portion of the specification that is allegedly prior art (Office Action, page 3). Again, applicant is unable to determine what the Examiner asserts is "admitted prior art" in the Detailed Description of the Invention and requests that the Examiner specifically identify what is contended to be "prior art" in this section.

Applicant acknowledges that the Detailed Description of the Invention makes reference to some known techniques and pieces of hardware or software that may be used to implement exemplary embodiments of the invention. For example, a database 14 may be accessed using known techniques (page 9, lines 12-16); data entry may be accomplished by any conventional means (page 9, lines 20-22); data 30, 32 may be entered, stored and managed using commercially available database software (page 9, lines 22-24); barcodes may be generated using commercially available software (page 10, lines 15-16); data may be entered into a computing device 18 using known techniques (page 11, lines 18-20); device 18 may be configured with commercially available hardware and software to capture a cursive signature (page 13, lines 22-24); data from device 18 may be transmitted via telecommunications medium 18 or other conventional

methods (page 13, lines 26-28); commercially available scheduling software may be used (page 14, lines 25-27); and commercially available software may be used to generate and print barcodes (page 14, lines 27-29).

However, the economically desirable fact that aspects of applicant's invention may be implemented using the above identified, commercially available components does not render applicant's invention to be "... merely a method of using conventional, well known computer equipment in order to implement and effect an automated method for accomplishing the same well known results as had heretofore been accomplished via manual means" (*emphasis added*; Office Action, page 3). The Examiner has not expressly identified any specific subject matter in the Background of the Invention or the Detailed Description of the Invention that constitutes "the same well known results as had heretofore been accomplished via manual means". The fact of the matter is that the so called manual means could not realistically provide any systematic technique that would have allowed the assignee of the present invention to conduct business operations in an economically efficient manner, and thus enabling to effectively compete in a ever-more globalized business environment.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03. The Examiner has not met this burden. The Examiner provides no factual basis supporting his position that every element recited in claims 1-27 achieves a heretofore known result previously accomplished by manual means other than applicant's own description of the invention.

Further MPEP §§2142 and 2143 outline that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to someone of ordinary skill in the art, to modify the reference or combine reference teachings. There must be a reasonable expectation of success and the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (*emphasis added*).

In this respect, the Examiner identifies no prior art sources for the motivation that would be required by one skilled in the art to arrive at the invention as claimed other than the Examiner's personal assertion that the motivation is "... simply to improve the efficiency of the information management process pertaining to the transport of a product between a point of origin and a point of destination by reducing the amount of manual effort required..." (*emphasis added*; Office Action, page 3). To begin with, it's not clear to applicant what constitutes "the information management process" and clarification is requested from the Examiner. The fact of the matter is that prior to the present invention there was no information management process. If anything there was a disarray of information that often resulted in costly and time consuming duplicative efforts in connection with the vast number of logistical details involved in the process of shipping thousands (if not millions) of consumer goods.

Further, absent an identification of any prior art source for the suggested motivation, the factual basis for this motivation could only have been derived from the Examiner's personal knowledge of the prior art. Consequently, in accordance with 37 C.F.R. §1.104(d)(2) applicant respectfully requests an affidavit from the Examiner with respect to the factual prior art basis supporting the Examiner's assertion that one skilled in the art would be so motivated.

Moreover, the Examiner concludes "... it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the conventional manual method of managing information pertaining to the transport of a product between a point of origin and a point of destination, ..." (*emphasis added*; Office Action, page 3). Applicant is unable to ascertain what constitutes "the conventional manual method" characterized by the Examiner or why such method forms the basis for rejection claims 1-27 under 35 U.S.C. §103(a). Consequently, in accordance with 37 C.F.R. §1.104(d)(2) applicant respectfully requests an affidavit from the Examiner with respect to what prior art reference the Examiner considers to define "the conventional manual method" used by the Examiner in his rejection.

In general, the present invention as delineated in independent claims 1 and 14, and claims depending there from, is a method for managing electronic data over a telecommunications system where the data relates to the transport of a product between two locations. Similarly, independent claim 20, and claims depending there from, delineates a system for managing the transport of the product. The delineated method and system set forth a unique combination of structural and/or operational relationships that result in more reliable and cost-efficient business operations in an ever-more competitive business environment, such as the one where the assignee of the present invention operates. The fact that the claimed structural and/or operational relationships are computer-based should not denigrate the present invention. In a practical business environment, the claimed method and system could not be realistically implemented as "... conventional manual methods..." as suggested by the Examiner and therefore could not accomplish "...the same well known results as had heretofore been accomplished via manual means..." as concluded by the Examiner.

The concepts of the present invention are defined in the methods and system of claims 1-27. The invention as so defined does not lie in the ability of one skilled in the art to implement a computer-based methodology, which seems to be the Examiner's sole contention without consideration of the claimed methods or system themselves.

It is also well settled that the Examiner may not rely upon hindsight to arrive at the determination of obviousness. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome, wherein that which only the inventor taught is used against its teacher. W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303. Applicant believes that the Examiner has fallen victim to this hindsight analysis trap by holding every element taught by applicant and claimed in claims 1-27 against the applicant. The Examiner concludes that applicant's invention would have been obvious to one skilled in the art without identifying

one prior art reference other than a vague reference to the applicant's own description of the invention as defined in those claims.

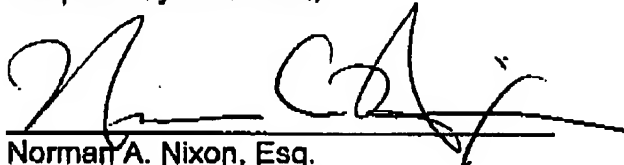
In view of the above, applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness, as detailed in MPEP §§2142 and 2143. As reasoned in the foregoing remarks, the Examiner has failed to specifically identify the prior art on which the Examiner bases his rejection and further has failed to identify the prior art from which one skilled in the art would have been motivated to arrive at the invention as claimed.

Consequently, applicant respectfully requests reconsideration of the merits of this invention and asserts that, based on the art of record to date, previously presented claims 1-27 are in condition for allowance. Notice to that effect is respectfully requested.

The Examiner is invited to call applicant's representative at the number below to discuss any aspects of this application to move it more expeditiously to allowance.

DATED this 7<sup>th</sup> day of October, 2004.

Respectfully submitted,



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